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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,494	10/31/2000	Nils Rydbeck	34650-608PT	2951
23932	7590	02/11/2004	EXAMINER	
JENKENS & GILCHRIST, PC 1445 ROSS AVENUE SUITE 3200 DALLAS, TX 75202			CHOW, DOON Y	
			ART UNIT	PAPER NUMBER
			2675	17

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,494

Applicant(s)

RYDBECK, NILS

Examiner

Dennis-Doon Chow

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/1/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-20, and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5, 8-20 and 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide support for "the predetermined threshold force being greater than a force present when the electronic reading device initially comes into contact with the specially formatted surface" as is claimed in claims 1, 8, 15 and 23.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8, 15-20, 22 –23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur (5852434) in view of Tuli (6348914).

Sekendur discloses a pen FIG. 7 for reading positional data FIGS. 1a-2 from a specially formatted surface FIG. 1 which comprises a data entry paper can be reusable. Optical detector 19 is disclosed within the pen. In col. 5, lines 36-39, it is disclosed that during the process of writing, the surface is scanned, data is sent to a processor and analyzed, and output to a screen. Sekendur further discloses a writing means that can be selectively activated and deactivated.

Sekendur does not disclose a sensor for detecting a contact between the electronic reading device and the specially formatted surface, and a wireless transmitter for transmitting the detected data.

Tuli teaches an electronic pen device comprising a pressure sensor for detecting a contact between the electronic pen device and a writing surface (see abstract), wherein the pressure sensor inherently includes a predetermined threshold force because a force must be applied in order to activate the pressure sensor; a memory for storing an inputted data; a wireless transmitter for transmitting the inputted data to a receiver (Fig. 2).

It would have been obvious to one of ordinary skill in the art to use Tuli's teachings in Sekendur's invention because the pressure sensor allows the pen to be turned on automatically when the pen is in use and off automatically when the pen is not in use. As to the use of the wireless transmitter, it eliminates the use of a cable transmission which limits the distance of the transmission.

5. Claims 9-14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur in view of Tuli as applied to claims 1-5, 8, 15-20, 22-23 and 25 above, and further in view of Wolff et al. (GB2306669A).

Sekendur does not disclose the use of a paper reprinted with at least one data entry field.

Wolff discloses a system using pen instrument 91 for writing on an ordinary document (p. 3., lines) or special documents such as Calendar Book. It is needed to identify a specified type of a special document, bar code 13 is used in conjunction with optical sensor 20. In p. 22, lines 5-8, it is disclosed that CCD 260 can identify local context within a document by identifying printed marks. Fig. 1 discloses an example 20 of a calendar book page. Page 20 is preprinted with columns of rectangles 22, 22' and other spaces for writing associated with time of day, with examples of handwriting and checkmarks shown.

In light of Wolff, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the formatted writing surface of Sekendur to include preprinted entry fields. This would have been obvious because more data can be entered to the specially formatted surface.

Response to Arguments

6. Applicant's arguments filed 12/1/2003 have been fully considered but they are not persuasive.

Applicant argues that the combination of Sekendur and Tuli fails to teach or suggest a detection of a contact between an electronic reading device and a specially formatted surface greater than predetermined threshold force. The examiner disagrees with applicant's arguments. As it is indicated in the above rejections, Tuli teaches an electronic pen device comprising a pressure sensor for detecting a contact between the electronic pen device and a writing surface (see abstract). The pressure sensor inherently includes means for predetermining a threshold force because a force must be applied in order to activate the pressure sensor. For these reasons, it is clear that the combination of Sekendur and Tuli teaches and suggests the detection of a contact between the electronic reading device and the specially formatted surface greater than predetermined threshold force.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis-Doon Chow whose telephone number is 703-305-4398. The examiner can normally be reached on 8:30-6:00, Alternate Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

D. Chow
February 10, 2004


DENNIS-DOON CHOW
PRIMARY EXAMINER